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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,147	11/25/2000	Paul Lapstun	NPS018US	4018
24011	7590	04/20/2004	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			KAO, CHIH CHENG G	
			ART UNIT	PAPER NUMBER
			2882	

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/722,147

Applicant(s)

LAPSTUN ET AL.

Examiner

Chih-Cheng Glen Kao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 14-25 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 25 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 20 and 23 are objected to because of the following informalities, which appear to be minor draft errors creating grammatical or lack of antecedent basis problems.

In the following format (location of objection, suggestion for correction), the following suggestions may obviate their respective objections: (claim 20, line 2, “is configured to prints”; replacing “prints” with - -print- -) and (claim 23, line 3, “the human discernable interface”; changing the dependency of claim 23 from claim 15 to claim 17).

For purposes of examination, the claims have been treated as such. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 14, 16, 17, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilz, Sr. et al. (US Patent 6152369) in view of Tsutsumoto et al. (JP 05-040841).

3. With regards to claim 14, Wilz, Sr. et al. discloses a viewing device (Fig. 3 and 15, #28) including at least one sensor (Fig. 3, #20) for sensing coded data on a substrate (Fig. 3, #8) and

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generating first data based at least partly on the coded data (Fig. 1B1), a transmitter (Fig. 3, #31) for transmitting data based on first data to a computer (Fig. 3, #2), a receiver (Fig. 3, #31) for receiving display data from the computer (Fig. 3, #2), and a display for outputting visual information based on display data (Fig. 3, #28) wherein the viewing device is arranged so that the sensor senses data when the viewing device is positioned, in use, at least partly overlapping the substrate (Fig. 3).

However, Wilz, Sr. et al. does not disclose a printer mechanism for printing on a substrate.

Tsutsumoto et al. teaches a printer mechanism for printing on a substrate (Abstract, Constitution).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to incorporate the device of Wilz, Sr. et al. with the printer of Tsutsumoto et al., since one would be motivated to incorporate a printer to provide a way of indicating the status of an article as implied from Tsutsumoto et al. (Abstract, Purpose).

4. With regards to claim 16, Wilz, Sr. et al. in view of Tsutsumoto et al. suggest a device as recited above.

However, Wilz, Sr. et al. does not disclose printed data corresponding partly with the display data or visual information.

Tsutsumoto et al. further teaches printed data corresponding partly with the data (Paragraph 003).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to further modify the device of Wilz, Sr. et al. with the printed data corresponding partly with data of Tsutsumoto et al., since one would be motivated to incorporate this to check the status of an item as implied from Tsutsumoto et al. (Paragraph 003).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the suggested device of Wilz, Sr. et al. in view of Tsutsumoto et al. with printed data corresponding partly with display data, since one would be motivated to have the user be aware of the status of an item as implied from Tsutsumoto et al. (Paragraph 003). For example, if the status of an item is completed, a decoded signal may send a signal to a remote central computer system, which collects data from all scanners, and then sends a signal back to the scanner to tell the user of the status of the item for stamping or not stamping.

5. With regards to claim 17, Wilz, Sr. et al. further discloses visual information corresponding to a human discernable interface on the substrate (Fig. 3, #8, 14, and 28).

6. With regards to claims 23 and 25, Wilz, Sr. et al. further discloses visual information representing an electronic document corresponding to a human discernable interface on the substrate visible to an average unaided eye (Fig. 3).

7. With regards to claim 24, Wilz, Sr. et al. further discloses visual information at least replicating some of the human discernable interface (Fig. 3 and 4).

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8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilz, Sr. et al. in view of Tsutsumoto et al. as applied to claim 14 above, and further in view of Danielson et al. (US Patent 6138915).

Wilz, Sr. et al. in view of Tsutsumoto et al. suggest a device as recited above.

However, Wilz, Sr. et al. does not disclose a display at least partly overlapping the sensor, such that the sensor is positioned between the display and coded data when the viewing device is in use.

Danielson et al. further discloses the display at least partly overlapping the sensor, such that the sensor is positioned between the display and coded data when the viewing device is in use (Figs. 23 and 36).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the suggested device of Wilz, Sr. et al. in view of Tsutsumoto et al. with the display, sensor, and data of Danielson et al., since one would be motivated to have this configuration to easily hold a device as implied from Danielson et al. (Figs. 23 and 36). Furthermore, rearranging parts of an invention involves only routine skill in the art. Such a rearrangement would have been an obvious modification.

9. Claims 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilz, Sr. et al. in view of Tsutsumoto et al. as applied to claim 14 above, and further in view of Goodwin et al. (US Patent 5900110).

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10. With regards to claim 18, Wilz, Sr. et al. in view of Tsutsumoto et al. suggest a device as recited above.

However, Wilz, Sr. et al. does not disclose a user interface and control means to print markings based on user input.

Goodwin et al. teaches a user interface and control means to print markings based on user input (Fig. 1, #13, and col. 1, lines 43-44).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the suggested device of Wilz, Sr. et al. in view of Tsutsumoto et al. with the user input of Goodwin et al., since one would be motivated to incorporate this for better user control and entering what one may want to label as implied from Goodwin et al. (col. 1, lines 39-44).

11. With regards to claim 19, Wilz, Sr. et al. further discloses a touch-sensitive overlay (Fig. 3, #29).

12. With regards to claims 20, recitations with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

13. With regards to claim 21, Wilz, Sr. et al. in view of Tsutsumoto et al. and Goodwin et al. suggest a device as recited above.

However, Wilz, Sr. et al. does not disclose printing after user input.

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Goodwin et al. further implies printing after user input (Fig. 1, #13, and col. 1, lines 39-44).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to further modify the suggested device of Wilz, Sr. et al. in view of Tsutsumoto et al. with the printing after user input of Goodwin et al., since one would be motivated to incorporate this to print a label when the user is finished to have data to be used for printing as implied from Goodwin et al. (col. 1, lines 39-44).

14. With regards to claim 22, Wilz, Sr. et al. in view of Tsutsumoto et al. and Goodwin et al. suggest a device as recited above. Wilz, Sr. et al. further discloses user input uploaded to a computer for downloading data based on uploaded data (col. 18, lines 40-44).

However, Wilz, Sr. et al. does not disclose computer data for printing on the substrate.

Tsutsumoto et al. further teaches computer data for printing on the substrate (Fig. 1(a), #5).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to further modify the device of Wilz, Sr. et al. with the computer data for printing on the substrate of Tsutsumoto et al., since one would be motivated to incorporate this to provide a means for showing the status of an article as implied from Tsutsumoto et al. (Abstract, Purpose).



***Response to Arguments***

15. Applicant's arguments with respect to claims 20-22 have been considered but are moot in view of the new ground(s) of rejection.

16. Applicant's arguments filed 12/19/03 have been fully considered but they are not persuasive.

Regarding arguments for paragraphs 3 and 8, Wilz, Sr. et al. also applies in a line environment for a stock of goods (Figs. 13 and 15). Thus, there is motivation to modify Wilz, Sr. et al. in view of Tsutsumoto et al. in order to check the status of an item as implied from Tsutsumoto et al. (Paragraph 003) as it goes through the routing system of Wilz, Sr. et al. (Fig. 13) by marking the article as a check before double reading (Tsutsumoto et al., Paragraph 008).

Regarding arguments for paragraphs 4, 6, and 7, Wilz, Sr. et al. shows display data related to the coded data (Fig. 3, #29). Since the printed data of Tsutsumoto et al. is partly related to the coded data as well, the combination of Wilz, Sr. et al. in view of Tsutsumoto would obviously have printed data at least partly based on the display data or visual information, since the printed data and display are both related to the coded data. One functional example may be as follows. A user scans the bar code, which sends a signal to a computer and back to the display screen showing the user that the good has already been processed. However, the user notices that there is no stamp and someone must have forgotten to stamp the goods and then places a stamp on it. Thus, the printed data is at least partly related to the display data in that the printed data indicates that the goods have been processed as indicated by the display data.

Regarding arguments for paragraphs 5-7, Wilz, Sr. et al. shows the apparatus displaying information accessed from the computer system (Fig. 15, #54A, and Fig. 16, "C").

Regarding arguments for paragraphs 10 and 13, the motivation for the combination of Wilz, Sr. et al. in view of Tsutsumoto et al. and Goodwin et al. is as recited above. This may be incorporated into Wilz, Sr. et al. by way of the application of information shown in Wilz, Sr. et al. (Fig. 12, "E") as motivated by Tsutsumoto et al.

Regarding arguments for paragraph 11, it is noted that the features upon which applicant relies (i.e., an interface operable to cause the printer mechanism to print markings) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Regarding arguments for paragraph 12, see paragraph 12 recited above.

Regarding arguments for paragraph 14, Tsutsumoto et al. was not relied upon for teaching user input. Wilz, Sr. et al. already disclosed the input. Furthermore, Tsutsumoto et al. does rely on downloading of information to mark goods as being read (Fig. 1, #5).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Cheng Glen Kao whose telephone number is (571) 272-2492. The examiner can normally be reached on M - F (9 am to 5 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Glick can be reached on (571) 272-2490. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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